| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/725,667 | 11/29/2000 | Barry Fellman | FELLMAN.001A | 9599 |

20995     7590     06/05/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

| EXAMINER |
|---|
| MAHMOUDI, HASSAN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2175 | |

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) | |
|---|---|---|---|
| **Office Action Summary** | 09/725,667 | FELLMAN, BARRY | |
| | Examiner | Art Unit | |
| | Tony Mahmoudi | 2175 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.          2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-18* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

  If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All  b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____ .

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

  a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it contains more than 150 words, and because it contains the term "disclosed" in lines 1 and 5. The abstract should be edited to contain no more than 150 words. Correction is required.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

   The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "aid," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. See MPEP §608.01(b).

   The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. See MPEP §608.01(b).

### *Claim Objections*

3. Claims 7-11 are objected to because of the following minor informalities:

   In claim 7, line 7, "veiw" should be changed to --view--.

   Claims 8-11 are objected to because they are dependents from objected-to independent claim 7.

## Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-15 recite the limitation "the search engine system as in claim 11" in line 1. There is insufficient antecedent basis for these limitations in the claims. For the purpose of examining the application, the examiner is making the assumption that claims 13-15 are dependents from independent claim 12 (not dependents from dependent claim 11.) Appropriate corrections are required.

## Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al (U.S. patent No. 6,519,589) in view of Schneider (U.S. patent No. 6,338,082.)

As to claim 1, <u>Mann et al</u> teaches a method of querying a domain name registry

database for a plurality of names to determine domain name registration availability

(see Abstract), the method comprising:

displaying a view allowing a user to specify a plurality of names to be checked for

availability in a domain name registry database (see figure 5A, block **504**);

receiving a set of names specified by the user, the set comprising a plurality of

names to be checked (see column 2, lines 55-56);

querying the registry database for the plurality of names (see column 2, lines 58-

60), where each name is checked with multiple Top Level Domain (TLD) extensions

(see column 8, lines 56-58); and

displaying query results for the plurality of names showing the availability of each

name in conjunction with each TLD extension (see figure 5D, and see column 8, lines

56-63.)

<u>Mann et al</u> does not teach displaying query results for the plurality of names in a

table.

<u>Schneider</u> teaches a method, product, and apparatus for requesting a network

resource (see Abstract), in which he teaches displaying query results for the plurality

of names in a table (see figure 5b, and see column 14, lines 1-7.)

Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to have modified <u>Mann et al</u> to include displaying

query results for the plurality of names in a table.

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have modified <u>Mann et al</u> with the teaching of <u>Schneider,</u>

because displaying query results for the plurality of names in a table would provide

additional information to the user viewing available domain names, as opposed to just

listing the available domain names.  Displaying the query results in a table, would

provide the option of "additional table entries" (e.g. columns) to be included, "such as

rates, time and expiration date (e.g., length of purchase time before renewal),

quantity, and customized discount methods, etc.", as taught by Schneider (see column

14, lines 7-10.)


As to claim 2, Mann et al as modified teaches wherein the displayed view permits

the user to specify the plurality of names by entering text strings (see Mann et al,

figure 5A, block **504**, where the name "tax" is entered in one of the four fields

designated for this purpose) from which the plurality of names are to be derived (see

Mann et al, figure 5D, where the previously entered name "tax" is used to derive a

plurality of names.)


As to claim 3, Mann et al as modified teaches wherein the query results table (see

Schneider, figure 5b) includes means for selecting multiple names to be submitted for

domain name registration (see Schneider, column 14, lines 13-20.)


As to claim 4, Mann et al as modified teaches wherein the means for selecting

comprises check boxes (see Mann et al, figure 5A.  Also see Schneider, figure 5a, and

see column 14, lines 13-14, where "selecting more than one record" is taught.  It is

obvious that in order to select more than one record from a displayed table, a

checkbox mechanism is provided in order for the user to view his selections as he continues selecting records from the list.)

As to claim 5, Mann et al as modified teaches wherein the view displayed includes a text window for user entry of the set of names (see Mann et al, figure 5A, block **504**.)

As to claim 6, Mann et al as modified teaches wherein the view displayed includes multiple text fields for user entry of the plurality of names (see Mann et al, figure 5A, and see column 4, lines 16-22.)

As to claim 7, Mann et al teaches in a computer system (see figure 1, block **102**, and see column 7, lines 2-3) that implements a domain name registration search (see column 5, lines 54-57, where "brokerage type services in the search process" is taught, and see column 7, lines 10-14), a method of checking the availability of and registering multiple names as domain names (see column 7, lines 31-39), the method comprising:

displaying an interface allowing a user to specify within a single view multiple names to be queried for availability (see figure 5A);

receiving a search query of names from the user (see figure 5A), the search query comprising multiple names entered by the user into the single view (see column 2, lines 55-56);

querying a database to determine registration availability of each of the multiple

names (see column 2, lines 58-60) in combination with each of multiple Top Level

Domain (TLD) extensions (see column 8, lines 56-58); and

displaying the availability of each name in conjunction with each TLD extension

(see figure 5D, and see column 8, lines 56-63.)

Mann et al does not teach: implementing a search engine; displaying a table

showing the availability of each name; and wherein the table is displayed in

conjunction with a selection mechanism for allowing the user to select one or more

available domain names for registration.

Schneider teaches a method, product, and apparatus for requesting a network

resource (see Abstract), in which he teaches implementing a search engine (see

column 6, lines 56-64); displaying a table showing the availability of each name (see

figure 5b, and see column 14, lines 1-7); and wherein the table is displayed in

conjunction with a selection mechanism (see figures 5a and 5b) for allowing the user

to select one or more available domain names for registration (see column 14, lines

13-14, where "selecting more than one record" is taught.)

Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to have modified Mann et al to include

implementing a search engine; displaying a table showing the availability of each

name; and wherein the table is displayed in conjunction with a selection mechanism

for allowing the user to select one or more available domain names for registration.

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have modified Mann et al with the teaching of Schneider,

because implementing a search engine would enable the user to access the domain

name availability system remotely from various available search engines; displaying a

table showing the availability of each name would provide additional information to

the user viewing available domain names, as opposed to just listing the available

domain names. Displaying the query results in a table, would provide the option of

"additional table entries" (e.g. columns) to be included, "such as rates, time and

expiration date (e.g., length of purchase time before renewal), quantity, and

customized discount methods, etc.", as taught by Schneider (see column 14, lines 7-

10); and because wherein the table is displayed in conjunction with a selection

mechanism for allowing the user to select one or more available domain names for

registration, would offer the user a selection of more than one available domain

names from a table, based on user's preference in cost, availability, etc., which would

provide the user the flexibility of viewing and comparing multiple available domain

names at the same time.


As to claim 8, Mann et al as modified teaches the method further comprising

providing the user an option to specify a plurality of name servers to be associated

with each domain name to be registered (see Schneider, column 9, lines 45-56.)


As to claim 9, Mann et al as modified teaches the method further comprising

receiving a submission from the user of multiple domain names to be registered (see

Mann et al, column 8, lines 52-53), and submitting the multiple names for registration

(see Mann et al, column 8, lines 64-67.)

As to claim 10, <u>Mann et al</u> as modified teaches the method further comprising after submission of the multiple domain names for registration, displaying a second table indicating, for each of the multiple domain names, whether registration was successful (see <u>Schneider</u>, column 12, line 57 through column 13, line 6.)

As to claim 11, <u>Mann et al</u> as modified teaches wherein the second table includes the expiration date for the domain name (see <u>Schneider</u>, column 14, lines 7-10.)

As to claim 12, <u>Mann et al</u> teaches a search system for allowing a user to query a database to determine the availability of multiple names for domain name registration (see Abstract, and see column 2, lines 58-62), the search system comprising:

a web page adapted for user entry and submission of a set of names to be checked for domain name registration availability (see column 3, lines 62-65), wherein the web page allows the user to enter and submit multiple names at a time (see figure 5B); and

a query server which is responsive to submission from the web page of a set of multiple names (see column 4, lines 6-8) by at least (a) determining registration availability of each of the names in combination with each of multiple Top Level Domain (TLD) extensions (see column 6, lines 11-17), and (b) generating results indicating, for each combination of a name and a TLD, extension, whether the combination is available for registration (see figure 5D.)

Mann et al does not teach a search engine system; and generating a results table.

Schneider teaches a method, product, and apparatus for requesting a network resource (see Abstract), in which he teaches a search engine system (see column 6, lines 56-64); and generating a results table (see figures 5a and 5b.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al to include a search engine system; and generating a results table.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al with the teaching of Schneider, because a search engine system would enable the user to access the domain name availability system remotely from various available search engines a results table; and because a results table would provide the option of "additional table entries" (e.g. columns) to be included, "such as rates, time and expiration date (e.g., length of purchase time before renewal), quantity, and customized discount methods, etc.", as taught by Schneider (see column 14, lines 7-10.)

As to claim 13, Mann et al as modified teaches wherein the web page is further adapted for user specification of the multiple TLD extensions (see Mann et al, column 7, lines 10-22.)

As to claim 14, Mann et al as modified teaches wherein the query server determines the registration availability of the names without requiring the user to specify the multiple TLD extensions (see Mann et al, column 7, lines 18-22, where

"the user may select a top level domain" is interpreted as an option as opposed to a

"requirement".)


As to claim 15, Mann et al as modified teaches wherein the results table (see

Schneider, figure 5b) includes means for selecting one or more available domain

names for registration (see Schneider, column 14, lines 13-20.)


As to claim 16, Mann et al teaches a method (see Abstract) of displaying

information on the availability of multiple names for registration as domain names

(see figure 5D), wherein a domain name registry database is queried to determine the

availability of the multiple names (see column 2, lines 58-60), the method

comprising:

displaying query results showing, for each of multiple names specified by a user,

the availability of multiple domain names for registration, wherein each domain name

is derived from one of the user specified multiple names combined with one of

multiple TLD extensions (see figures 5A and 5D.)

Mann et al does not teach displaying a results table; and for each of the multiple

domain names available for registration, providing a selection mechanism within the

query results table to permit the selection of one or more available domain names for

registration.

Schneider teaches a method, product, and apparatus for requesting a network

resource (see Abstract), in which he teaches: displaying a results table (see figure 5b,

and see column 14, lines 1-7); and for each of the multiple domain names available

for registration, providing a selection mechanism (see figures 5a and 5b) within the

query results table to permit the selection of one or more available domain names for

registration (see column 14, lines 13-14, where "selecting more than one record" is

taught.)

Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to have modified Mann et al to include displaying

a results table; and for each of the multiple domain names available for registration,

providing a selection mechanism within the query results table to permit the selection

of one or more available domain names for registration.

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have modified Mann et al with the teaching of Schneider,

because displaying a results table would provide additional information to the user

viewing available domain names, as opposed to just listing the available domain

names. Displaying the query results in a table, would provide the option of

"additional table entries" (e.g. columns) to be included, "such as rates, time and

expiration date (e.g., length of purchase time before renewal), quantity, and

customized discount methods, etc.", as taught by Schneider (see column 14, lines 7-

10); and because for each of the multiple domain names available for registration,

providing a selection mechanism within the query results table to permit the selection

of one or more available domain names for registration, would offer the user a

selection of more than one available domain names from a table, based on user's

preference in cost, availability, etc., which would provide the user the flexibility of

viewing and comparing multiple available domain names at the same time.

As to claim 17, <u>Mann et al</u> as modified teaches wherein the selection mechanism

comprises check boxes (see <u>Mann et al</u>, figure 5A.  Also see <u>Schneider</u>, figure 5a, and

see column 14, lines 13-14, where "selecting more than one record" is taught.  It is

obvious that in order to select more than one record from a displayed table, a

checkbox mechanism is provided in order for the user to view his selections as he

continues selecting records from the list.)


As to claim 18, <u>Mann et al</u> teaches a method of querying a domain name registry

database to determine domain name registration availability (see Abstract, and see

column 2, lines 58-60), the method comprising:

displaying a view allowing a user to specify a name to be queried (see figure 5A)

for availability as a Second Level Domain (SLD) in a domain name registry database

(see column 8, lines 24-32);

querying the registry database for the name in combination with multiple Top

Level Domain (TLD) extensions not specified by the user (see column 2, lines 58-

60); and

displaying query results for the name showing the availability of the name (see

figure 5D.)

<u>Mann et al</u> does not teach receiving from the user the name to be queried for

availability as the SLD; displaying query results in a table; and showing the

availability of the name as a SLD in conjunction with each TLD extension.

Schneider teaches a method, product, and apparatus for requesting a network

resource (see Abstract), in which he teaches: receiving from the user the name to be

queried for availability as the SLD (see column 3, line 66 through column 4, line 12);

displaying query results in a table (see figures 5a and 5b); and showing the

availability of the name as a SLD in conjunction with each TLD extension (it is

obvious that a system displaying available domain names for registration includes all

the required names and the extensions (TLD, SLD, etc.) specified by the user .)

Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to have modified Mann et al to include receiving

from the user the name to be queried for availability as the SLD; displaying query

results in a table; and showing the availability of the name as a SLD in conjunction

with each TLD extension.

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have modified Mann et al with the teaching of Schneider,

because displaying query results in a table would provide additional information to

the user viewing available domain names, as opposed to just listing the available

domain names. Displaying the query results in a table, would provide the option of

"additional table entries" (e.g. columns) to be included, "such as rates, time and

expiration date (e.g., length of purchase time before renewal), quantity, and

customized discount methods, etc.", as taught by Schneider (see column 14, lines 7-

10); and because receiving from the user the name to be queried for availability as the

SLD; and showing the availability of the name as a SLD in conjunction with each

TLD extension, would enable the user to check for availability of, and register

personalized (customized) domain names, comprising a root name, a top level

domain, and an additional second level domain extension (e.g. "my.8-1.com".)

## *Conclusion*

8.  Any inquiries concerning this communication or earlier communications from the

examiner should be directed to Tony Mahmoudi whose telephone number is (703)

305-4887.  The examiner can normally be reached on Mondays-Fridays from 08:00

am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici, can be reached at (703) 305-3830.

tm

May 29, 2003

DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100